UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/637,053	08/11/2000	Cynthia Calonge	22554.2	7195

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COX SMITH MATHEWS INCORPORATED
112 EAST PECAN STREET, SUITE 1800
SAN ANTONIO, TX 78205-1521

EXAMINER
NGUYEN, CUONG H

ART UNIT	PAPER NUMBER
3661	

DATE MAILED: 10/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/637,053	CALONGE, CYNTHIA
	Examiner	Art Unit	
	CUONG H. NGUYEN	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 May 2004*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6* is/are pending in the application.

    4a) Of the above claim(s) *2 and 3* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-6* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 August 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

1.   This Office Action is the answer to the amendment received on 5/17/2004.

Status of the Claims

2.   Claim 1 is pending in this application. Claims 2-3 were cancelled; new claims 4-6 are added.

Response

3.   The arguments of the applicant submitted on 5/17/2004 are unpersuasive since although Giovannoli's patent may not be an art for 35 USC 102 rejection, the claimed steps are still obvious for a method for providing online submission of request for proposals for forwarding to identified vendors (please note that for step g) of pending claim 1, it is obvious for artisans to understand that selecting a vendor to "receive said RFP information" although it is not in original claim because that is what selection process for. In the abstract, Giovannoli discloses "means for network buyer to generate request for quotation for goods" (pending claim 1, step b), this is similar to requesting for proposal. It is obvious for a step of reviewing potential vendors (manually or automatically) of pending claim 1, step f); and it would be obvious for Giovannoli to suggest about selecting one potential vendor among a sub-list of potential vendors (a narrower list). New claims are added; therefore, new grounds of rejections are necessitated.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms

the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4.   Claim 1 is rejected under 35 U.S.C. 103(a) as being

unpatentable over Giovannoli. (US Pat. 5,758,328).

A. <u>As per independent claim 1</u>:   Giovannoli suggests a

method for establishing and brokering a transaction between

purchasers and vendors over a wide area network (see

Giovannoli, Fig.1);

Giovannoli teaches of providing a database of vendor

information to a buyer for review, Giovannoli discloses "For

this reason existing centralized database systems are created and maintained by the one or

a few vendors whose goods and prices are displayed. These systems necessarily restrict a

buyer's choice of vendors." This means a list of vendors is selected

for claimed transaction.

-     description of the goods and services required by a

purchaser (see Giovannoli, the abstract)

-     Giovannoli discloses a step of "comparing required

goods/services of a buyer to those of a sellers database) this is similar to "request for

proposal" (from vendors); "In the preferred embodiment the vendor class of

network members are filtered to be selected based on their likelihood to respond to the

request for quotation. Alternatively, or in addition, the vendor responses may likewise be

filtered to satisfy conditions of the vendors responding or in accordance with predefined

conditions for facilitating a linkage between the prospective buyer and an acceptable

seller."

Giovannoli discloses a request for quote (from vendors)

this is similar to "request for proposal" (from vendors); and "12.

A method of purchasing goods or services over a data network comprising the steps of:

communicating, over said data network, to a filter means, at least one request for a

quotation from a potential buyer of said goods or services; filtering, at said filter means,

the at least one request in order to ascertain a set of sellers potentially capable of

supplying said goods or services; and obtaining, from at least one of said potential sellers,

over a data network, quotes to supply said goods or services, and forwarding said quotes

to said potential buyer, wherein at least part of the quote information is stored at a

location remote from said filter means."

And "15. The method of claim 12 wherein said step of obtaining comprises the step of

each seller contacting said filter means at predetermined intervals and supplying bids in

response to any requests for proposal that have arrived at said filtering means and that

were determined, by the filter means, to be a request for proposal for goods or services

which said each seller is potentially capable of supplying.".

And Giovannoli also suggests about identifying vendors

in a database offering goods and services similar to a

buyer's requirement in claim 17 of his patent.

" 17. A method of matching buyers of goods and services with sellers of goods and services over a data network comprising the steps of; communicating, from buyers to a filter means, requests for quotes (RFQs); filtering said RFQs so that only sellers meeting a first set of filter conditions receive said RFQs; transmitting, to remotely located seller databases, the filtered RFQs; accepting quotes from sellers meeting said first set of filter conditions, and filtering said quotes so that only quotes meeting additional filter conditions are sent to a buyer requesting said quotes."

Giovannoli also teaches about "comparing said description of the goods and services required by said at least one potential purchaser in said RFP information with said descriptions of the goods and services offered by said plurality of vendors in said vendor database, said comparing step carried out by computer" similar to a buyer's requirement in claim 4 of his patent.

" 4. A computerized system for engaging in transactions over a data network, said computerized system comprising: plurality of terminals, at least one of which being designated a requestor and others of which are designated vendor terminals; filter and broadcast means for receiving, over said data network, requests from said requestor to engage in transactions with unspecified vendor terminals, and for filtering said requests to determine with which vendor terminals said requests should be matched; and means for matching said requests with vendor terminals which meet predetermined filter conditions for generating quotes from information contained in a database associated with said vendor terminals, and for accepting said quotes from said vendor terminals, wherein the central database contains information that is insufficient to consummate the transaction."

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The next claimed step is an automatically identifying vendors, Giovannoli teaches that using computer filtering to identifying vendors (see claim 4).

The next claimed step is "generating a sub-list of vendors who are identified", Giovannoli suggests that using computer filtering to identifying vendors (see **Giovannoli**, claims 4, 13 "13. The method of claim 12 further comprising the step of accepting filtering conditions from said potential buyer, and utilizing said filtering conditions in said step of filtering to determine a subset of potentially capable sellers.") and generating it via displaying.

It is obvious that selecting a vendor from above step by a buyer because this is a reason why there is a filtering step from Giovannoli's patent "In the preferred embodiment the vendor class of network members are filtered to be selected based on their likelihood to respond to the request for quotation. Alternatively, or in addition, the vendor responses may likewise be filtered to satisfy conditions of the vendors responding or in accordance with predefined conditions for facilitating a linkage between the prospective buyer and an acceptable seller.".

It is obvious that there is a bi-directional communication between selected potential vendors and a buyer after filtering/matching them with buyer's request (see Giovannoli, claim 17 "accepting quotes from sellers meeting said first set of filter conditions, and filtering said quotes so that only quotes meeting additional filter conditions are sent to a buyer requesting said quotes.") (this teaches a step

of "communicating an acceptance or a rejection from a buyer to a selected potential vendor" because this is a purpose of that patent.

In summary, Giovannoli suggests a method for establishing and initiating a transaction between purchasers and vendors over a wide area computer network, comprising:

- providing a vendor database, said database comprising information on vendors, said information comprising a description of the goods and services offered by said vendors (see Giovannoli, 4:40-45);

- providing a request for proposal to a purchaser over said network (see Giovannoli, the abstract and Figs.1, 4);

- receiving said request for proposal from a purchaser, said proposal comprising a description of the goods and services required by said purchaser (see Giovannoli, the abstract and Figs.1, 4);

- comparing said proposal's info. with said info. in a vendor database then identifying vendors in said vendor's database offering goods and services that are similar to said goods and services required by said purchaser (see Giovannoli, claim 4 and Fig.6);

- communicating said proposal's info. to identified vendors (see Giovannoli, the abstract and Figs.1, 4);

- communicating a response from identified vendors to said purchaser, said response comprising a proposal to provide

goods and services to said purchaser (see Giovannoli, the
abstract).

5. **Claims 4-6 are rejected under 35 U.S.C. 103(a) as being**
unpatentable over Giovannoli. (US Pat. 5,758,328).

A. As per independent claim 4:   Giovannoli suggests a
step of receiving information from potential purchaser (see
Giovannoli, Fig.4) via World-Wide-Web further comprises
receiving vendor selection criteria (after filtering based
on "FILTER CRITERIA").

It would have been obvious to one of ordinary skill in
the art that Giovannoli suggests a criteria for selecting
vendors was supplied by a buyer/purchaser after reviewing
vendor information because a level of selecting based on
buyer criteria is more sufficient and practical compared to
given a "tough" criteria that none of the vendor can meet.

B. As per independent claim 5:   Giovannoli also suggests
a step of communicating a response from a selected potential
vendor to a potential purchaser (via FTP and "CENTRAL
OFFICE" (see Giovannoli, Fig.4), comprising a potential
vendor reviewing RFP information, generating
a proposal in response to said RFP information, and
transmitting said proposal to a potential purchaser.
These above steps are suggested by Giovannoli in Fig.4 by
showing arrows for bi-directional exchanging communication
between a purchaser/buyer and a selected vendor.

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It would have been obvious for one of ordinary skill in the art to appreciate the above claimed ideas from Giovannoli for a transaction between purchasers and vendors over a computer network.

C. As per independent claim 6: Giovannoli suggests a step of exchange a communication a response from a selected potential vendor to a potential buyer, comprising reviewing said RFP by a vendor, generating a proposal in response to said RFP information, and transmitting said proposal to a potential purchaser (see Giovannoli, Fig.4).

It would have been obvious for one of ordinary skill in the art to appreciate the above claimed ideas from Giovannoli's suggestion for a transaction between purchasers and vendors over a computer network.

Conclusion

6. Claims 1, 4-6 are unpatentable. THIS ACTION IS MADE FINAL because it necessitates a new ground(s) of rejection. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-330 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625